



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/494,643	01/31/2000	Jean-Marc Halbout	SMS999-002	3730

7590

07/03/2002

IBM CORPORATION  
Anne Vachon Dougherty ESQ  
3173 Cedar Road  
Yorktown Heights, NY 10598

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/494,643

Applicant(s)

HALBOUT ET AL

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 6; claim 12, line 6; claim 15, line 6; and claim 16, line 8, respectively, the phrase "type" renders the claims indefinite because the claims would include elements not actually disclosed (those encompassed by "type"; what kind of usage is defined to fit a particular case?), thereby rendering the scope of the claims unascertainable.

***Claim Rejections - 35 USC § 101***

- 3) 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 4) Claims 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim merely manipulates an abstract idea without producing a "useful, concrete and tangible result". Because the "data structure" as claimed by Applicants is deemed to be the mere collection of a plurality of data matrix, which may not be

Art Unit: 3629

considered as the readable medium, without showing any relationship between a plurality of matrix entries (first and second), the structure would not produce the useful, concrete and tangible result.

***Claim Rejections - 35 USC § 102***

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6) Claims 1-2 and 5-16, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Hernandez et al. (US 6,208,977).

Hernandez et al. discloses a method for valuation of sever-based computer services for each of a plurality of computer server systems comprising the steps of:

assigning a capacity value for each computer server system (see generally Figs. 2B, 4A, 4B, 5);

assigning a usage environment for each computer server system (see generally Figs. 2B, 4A, 4B, 5);

mapping the capacity value and usage environment (see generally Figs. 2B, 4A, 4B, 5);

assigning costs according to mapping (see generally Figs. 2B, 4A, 4B, 5);

assigning a capacity value including assigning a value based on the size of the server system;

calculating a capacity value from at least one previously-assigned capacity value; (see Fig. 4B);

assigning a usage environment based on the server application;

ascertaining at least one service support level (amount, type and skill) (see generally col. 3 and col.4); and

mapping each of the at least one service support level into other data (see generally Figs. 2B, 4A, 4B, 5).

Hernandez et al. also discloses a data structure comprising (see generally Figs. 2B, 4A, 4B, 5):

a first plurality of matrix entries;

a second plurality of matrix entries: and

a plurality of costs assigned to the services.

Hernandez et al. discloses a system for providing valuation of server-based computer services, comprising:

assignment component for assigning a capacity value for each computer server system (see generally Figs. 2B, 4A, 4B, 5);

a usage assignment component for assigning a usage environment for each computer server system (see generally Figs. 2B, 4A, 4B, 5);

processor component for mapping the capacity value and usage environment (see generally Figs. 2B, 4A, 4B, 5); and

cost processing component for assigning costs according to mapping (see generally Figs. 2B, 4A, 4B, 5).

Hernandez et al. discloses a program storage device readable performing the method of steps of:

assigning a capacity value for each computer server system (see generally Figs. 2B, 4A, 4B, 5);

assigning a usage environment for each computer server system (see generally Figs. 2B, 4A, 4B, 5);

mapping the capacity value and usage environment (see generally Figs. 2B, 4A, 4B, 5); and

assigning costs according to mapping (see generally Figs. 2B, 4A, 4B, 5).

7) Claims 1-2 and 6-16, as far as they are definite, are rejected under 35 U.S.C. 102(e) as being anticipated by Saari et al. (US 6,338,046).

Saari et al. discloses a method for valuation of sever-based computer services for each of a plurality of computer server systems comprising the steps of:

- assigning a capacity value for each computer server system (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

- assigning a usage environment for each computer server system (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

- mapping the capacity value and usage environment (see generally Figs. 2, 4, 5);

- assigning costs according to mapping (see generally Figs. 2, 4, 5);

- assigning a capacity value including assigning a value based on the size of the server system;

- assigning a usage environment based on the server application (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

- ascertaining at least one service support level (amount, type and skill) (see generally Figs. 2, 4, 5; col. 4, lines 18-42); and

- mapping each of the at least one service support level into other data (see generally Figs. 2, 4, 5).

Saari et al. also discloses a data structure comprising (see generally Figs. 2, 4, 5; col. 4, lines 18-42):

- a first plurality of matrix entries;

- a second plurality of matrix entries: and

- a plurality of costs assigned to the services.

Saari et al. discloses a system for providing valuation of server-based computer services, comprising:

assignment component for assigning a capacity value for each computer server system (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

a usage assignment component for assigning a usage environment for each computer server system (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

processor component for mapping the capacity value and usage environment (see generally Figs. 2, 4, 5); and

cost processing component for assigning costs according to mapping (see generally Figs. 2, 4, 5).

Saari et al. discloses a program storage device readable performing the method of steps of:

assigning a capacity value for each computer server system (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

assigning a usage environment for each computer server system (see generally Figs. 2, 4, 5; col. 4, lines 18-42);

mapping the capacity value and usage environment (see generally Figs. 2, 4, 5);  
and

assigning costs according to mapping (see generally Figs. 2, 4, 5).



***Claim Rejections - 35 USC § 103***

8) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9) Claims 3-4, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez et al. in view of the Applicants' admitted prior art.

Hernandez et al. discloses the invention as recited earlier, but does not expressively disclose the method including the steps of:

assigning a capacity value including assigning a value based on the number of CPUs in the server system; and

assigning a capacity value including assigning a value based on published standards.

Applicants' admitted prior art (see generally pp 7-9) teaches, for a method for valuation of server-based computer services, that the published benchmark results are used to determine capacity units.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to assign the capacity value including a value based on the published standards (including the number of CPUs in the server system), as taught by the Applicants' admitted prior art, for the purpose of determining the relative server system performance across various make and model types and vendors.

Art Unit: 3629

10) Claims 3-4, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Saari et al. in view of the Applicants' admitted prior art.

Saari et al. discloses the invention as recited earlier, but does not expressly disclose the method including the steps of:

assigning a capacity value including assigning a value based on the number of CPUs in the server system; and

assigning a capacity value including assigning a value based on published standards.

Applicants' admitted prior art (see generally pp 7-9) teaches, for a method for valuation of server-based computer services, that the published benchmark results are used to determine capacity units.

Accordingly, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to assign the capacity value including a value based on the published standards (including the number of CPUs in the server system), as taught by the Applicants' admitted prior art, for the purpose of determining the relative server system performance across various make and model types and vendors.

### ***Conclusion***

11) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

IBM Publication is cited to show the Channel programming to keep the channel

Art Unit: 3629

running at 100% utilization and present an interrupt to applications.

US 5,978,577 is cited to show a method and apparatus for transaction processing in a distributed database system.

US 6,086,618 is cited to show a method for developing system usage cost equations, creating models based upon cost equations and estimating total system usage.

US 6,314,465 is cited to show a method and apparatus for load-sharing (load-balancing) on a WAN.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo  
Patent Examiner  
GAU 3629  
June 29, 2002



John G. Weiss  
Supervisory Patent Examiner  
Group 3600